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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,988	12/19/2001	Graeme Milbourne Clark	1473-070	2573
22506	7590	06/15/2004	EXAMINER	
JAGTIANI + GUTTAG 10363-A DEMOCRACY LANE FAIRFAX, VA 22030			DROESCH, KRISTEN L	
			ART UNIT	PAPER NUMBER

3762

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/018,988

Applicant(s)

CLARK ET AL.

Examiner

Kristen L Droesch

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 is/are allowed.
- 6) ☒ Claim(s) 10-15, 17 and 18 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 13 recites the limitation "the mastoid cavity" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 10-15, and 17-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Schulman et al. (6,067,474).

Regarding claim 10, Schulman et al. shows an implant package comprising: a protective housing (112') containing stimulator electronics; at least one electrode (114) adapted for insertion into an inner ear and in operable communication with said stimulator electronics, a receiving and/or transmitting coil (172) enclosed in a protective casing (silicone rubber mold 174); and wherein a flexible connection (silicone rubber

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mold 174) is provided between and directly attached to said protective housing and said protective casing (Figs. 14A-14B; Col. 16, lines 10-49).

With respect to claim 11-12, Schulman et al. shows the flexible connection could facilitate optimal positioning of the coil and the flexibility of the flexible connection between the protective housing and the protective casing is such as to allow changes in head shape as the patient grows since silicone rubber is capable of compression.

With respect to claim 13, Schulman shows the flexible connection is made from a material having memory. It is inherent that silicone rubber has a memory since it is an elastomer and therefore will revert back to its original shape after mechanical force is applied to the material.

Regarding claim 14-15, Schulman et al. shows the protective housing (112) is electrically coupled to the at least one electrode (114) and the protective housing is electrically coupled to the receiving or transmitting coil via inductive coupling with coil inside protective housing.

With respect to claim 17, Schulman et al. shows the implant package (74) is a receiver/stimulator package and said at least one electrode (114) is adapted for insertion into the inner ear.

The functional language and statements of intended use have been carefully considered but are not considered to impart any further structural limitations over the prior art.

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Response to Arguments

6. Applicant's arguments, see paper filed 4/21/04, with respect to claims 1-9 have been fully considered and are persuasive. The rejection of claims 1-9 has been withdrawn.

Allowable Subject Matter

7. Claim 1-9 are allowed.

8. Claim 16 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The prior art of record fails to teach or suggest an implant package comprising a protective housing containing stimulator electronics, at least one electrode adapted for insertion into an inner ear and in operable communication with the stimulator electronics; a receiving and/or transmitting coil enclosed in a protective case, a flexible connection provided between and directly attach to the protective housing and the protective casing, all in combination with the flexible connection including one or more flexible arms containing leads which electrically connect the implant electronics to the receiving and/or transmitting coil.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristen L Droesch whose telephone number is 703-605-1185. The examiner can normally be reached on M-F, 10:00 am - 6:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angie Sykes can be reached on 703-308-5181. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

kld

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Angela D. Sykes

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